

REMARKS

I. Claim Rejections – 35 USC 112

The examiner rejected claims 1-38 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The examiner argued that Applicant's specification fails to mention that the SVG format is used as an input format for documents or used downstream in a workflow to be used as a format for input data. Also, the examiner further argues that the specification fails to mention anything about a family of CNF files used. The examiner requests specific citations from instant application regarding alleged new matter in claims 1, 2, 20, and 21.

The Applicant responds by retracting the use of the term "family of CNF files" and specific citation of SVG format usage; however, retains the inclusion of SVG solution-independent formatting with the broad group of Common Normal Formats (CNF) as suggested by the Examiner. It, however, is still not clear as to why such a group, in general terms, cannot be referred to as a "family" when the term "family" does not add any special meaning. Also, regarding specific limitations regarding the use of SVG formatting the claims have been amended to broaden the scope of the claim to keep in alignment with the instant application.

II. Response to arguments relating to rejections in Non-Final Office Action dated October 28, 2009 and basis for amendments.

In light of Examiner's broad interpretation of the Kato '236 reference regarding solution-independent formatting and its ability to manage an electronic original writer as a device driver with a bookbinding application, the Applicant is further narrowing the claims to make apparent Kato '236 inability to disclose all novel aspects of the instant invention.

Claim 1, as amended, requires "generating said at least one book from said book files utilizing hardware and software to shape said framework in order to accommodate solution-independence within said book files, directly, without conversion from an equipment dependent format through a bookbinding process as prescribed by a just-in-time production scenario." Support in the application can be found in paragraph [0023] disclosing a book reproduction system with customized hardware and software allowing for the creation of "solution-independent master book files directly without any conversions" to solution-dependent formatted files.

The newly amended claims as well reflect the limitations of editing, viewing and printing of the generated e-book as detailed in paragraph [0027] and figure 3 of 4, logical block 308, of instant application. It should also be noted the preamble of independent claims 1 & 20 have further defined "said book" to include said plurality of books encompassing one or more units. Further note throughout the claims "said book" has been amended to "said at least one book" for consistency.

In contrast to the substantive amendments detailed above, Kato '236, as interpreted by the Examiner on page 3 (top) of Non-Final Office Action dated on October 28, 2009 states "When an application utilizes an electronic original writer (1020, figure 9), the electronic original writer (1020) is designated for certain functions but does not produce a complete electronic original file (1030, figure 9) format until the electronic original writer (1020) is under the management of the bookbinding application (1040, figure 9) of the electronic original writer (1020) and the device driver designation of the electronic original writer (1020) to perform the conversion of the actual document into another format that is intermediate, the system then deems the electronic original file (1030) format in the intermediate file format to be complete. With the bookbinding application (1040) being used to give the electronic original file (1030) structure while assisting in the conversion of the application data, this is seen as contributing to the completing of the electronic original file (1030), which is also referred to as an intermediate code or an intermediate file format. The intermediate file format is then able to be manipulated by the bookbinding application (1040) for further structuring of the converted document and editing."

As evident from the above caption, Kato '236 is based on a complex conversion scheme going from equipment specific formatting to independent formatting when processing an electronic book for printing (1070, figure 9). In contrast, the instant application is always staying in the XML framework to steer clear of confusing conversion processes which are counterproductive to "just-in-time" workflow preparedness. Neither does Kato '236 possess such an architecture, nor can it adequately support any modification taught by a secondary reference without destroying its original concept.

Claim 2 has been cancelled, removing specific SVG formatting limitations as suggested by the examiner.

Claims 3-19 have been generally modified to adjust syntax and further define JDF role in the production pipeline.

Claim 20 has been further limited to distinguish software and hardware roles, as relating to solution-independent electronic book file processes, than that found in the book binding system disclosed in Kato '236. These distinctions have a direct correlation with changes in amended method claim 1 as stated above.

Claim 21 further discloses editing capabilities by further limiting the claim by adding the phrasing "wherein said at least one solution-independent book file can be edited with content disposition and advertising within the XML framework irrespective of the project completion level." It is the Applicant's position that Kato '236 is required to work in both equipment-dependent formats and solution-independent formats, in partnership, to complete the bookbinding process as clearly defined in Kato '236 and contextualized by Examiner in the Non-Final Office Action dated October 28, 2009, page 3 (top) (see caption above). Applicant would like to further note that it is well known in the art that CNF, e.g. SVG, can directly communicate with the printer in a "printer driver" role, avoiding equipment specific dependency. Although, the examiner may argue that Kato may have the capability to mimic such a SVG function detail, it is apparent from Kato '236 architecture shown in figure 1 that there is no direct information flow between the "intermediate code storage module" (109, figure 1, Kato) and the printer (102. 103, figure 1, Kato). The despooler in figure 9 of Kato '236 and any associated printer conversion modules will invariably have equipment specific features. And as further evidenced in paragraph [0122] specific language describes book reproduction integrated architecture functioning by selecting specific equipment dependent drivers or "printer driver corresponding to a printer".

And furthermore, Kato '236, paragraph [0061], phrasing states "The bookbinding application 1040 provides no function of editing the contents of each page, but a function of editing a chapter or book structure made up of pages of the individual unit" reinforces Kato '236 inability to edit pages throughout the bookbinding process, especially within the required solution-independent confines.

For instance, the instant application places no limitations within its architecture on editing, such as, its ability to insert an advertisement onto a random page during workflow or the “bookbinding process.” Figure 9 shows Kato’s workflow having a pivotal role around the “bookbinding application” (1040) and since, for instance, within this segment of the process an advertisement cannot be inserted, the limitation “irrespective of project completion level” is not met.

Regarding claims 28 and 33, utility of an “equipment-dependent format converter” have been removed from the limitations to stress an embodiment consisting of purely solution-independent formatting.

In conclusion, the above stated modifications reflect an XML pipeline extending the entire prepress project length for seamless production utilizing “reproduction hardware and software that can reproduce the solution-independent master book directly without conversion” as described in paragraph [0023] of applicant’s specification.

Regarding the rejection of claim 20, as amended, the claim now requires that the reproduction hardware and software reproduce a solution-independent book file, from said book file generator, directly, without any said book file format conversion as prescribed by an efficient just-in-time production scenario. Above was discussed in length regarding amended method claim 1 allowability, and for these same reasons the Applicant respectfully requests withdrawal of amended system claim 20 rejection. Regarding claim 21, Kato ‘236 fails to disclose a book printing system that can edit at the page level throughout the process. As stated in Kato ‘2003/0103236’, paragraph [0061], “The bookbinding application 1040 provides the user with a function of loading and editing the electronic original file 1030. The bookbinding application 1040 provides no function of editing the contents of each page, but a function of editing a chapter or book structure made up of pages in the minimum unit.”

The Applicant interprets the above excerpt to define a segment of production workflow with a void in editing capabilities. As shown clearly in workflow diagram shown in figure 9 of Kato, the bookbinding application is located between the electronic original file 1030 (storage medium) and the printer 1070 (end of

prepress workflow) and provides therein no resource to edit text and therefore cannot meet the limitation requiring “wherein said at least one solution-independent book file can be edited with content disposition and advertising within the XML framework irrespective of the project completion level.” In other words when the Kato workflow is utilizing the bookbinding application it is at a stage that the system is void of editing capabilities, e.g. cut and paste an advertisement, and therefore, not “irrespective” of workflow positioning. Amended claim 1 further narrows the scope of this feature down by adding “said editing instruction set accessible throughout an XML prepress pipeline shaped by said XML framework.” With the above stated reasons the Applicant respectfully submits his motion in the case to persuade the examiner to suspend all rejections and move all claims to allowance.

The Applicant would also like to address a statement made in the **Conclusion** section of the Non-Final Office Action, dated October 28, 2009, wherein the Examiner cites as qualified prior art a relative application published in Japan, namely JP2003281226A. However, **MPEP Section 706.02(a) I B titled 35 USC 103(e)** requires references under this requirement that the inventive entity of the application must be different than that of the reference. Please note that both applications have only **Levine** as their inventor and share the same assignee, that being IBM, and therefore, are the same inventive entity. Please note that the foreign application JP2003281226A has a published date of October 3, 2003 and the instant application is dated January 16, 2004, which is non-statutory, and therefore, inapplicable under 102(e).

II. Claim Rejections - 35 USC §103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. *a reasonable expectation of success; and*
2. *the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).*

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Kato in view of Sangroniz

The Examiner rejected claims 1, 9-11, 14-17, 20, 21, 28-30 and 33-36 under 35 U.S.C. §103(a) as being unpatentable over Kato (U.S. Patent Publication No. 2003/0103236) in view of Sangroniz (U.S. Patent Publication No. 2005/0050466) in a May 14, 2009 Final Action and further justified the rejections in a July 29, 2009

Advisory Action. In response to said rejections the applicant submits newly amended claims 1, 4-8, 12, 13, 20, 21, 23-27, and 31, to more clearly define the instant application's inventive entity.

Regarding claim 1 rejection, Kato allegedly discloses a print-on-demand method for creating and reproducing books by heterogeneous systems, said method comprising the steps of:

a) obtaining and generating book files in portable document format (PDF), job definition format (JDF), and scalable vector graphics (SVG) format, being further defined as formats, wherein said formats comprising a family of common normal format (CNF) files, retrieved from or sent to at least one of a memory, scanner and network, said book files including book identification information and book production information, wherein said book files are compiled into a digital representation of a book targeted for reproduction;

b) converting said book files reflecting attributes imposed by said JDF into a master book embodied in the CNF files that are reproduction system and solution-independent;

c) storing at least one of said family of CNF files in memory within a repository as a mastered book;

d) determining if the at least one of the said family of CNF files need to be converted into equipment specific format files based on a book reproduction system to be utilized for reproduction and if conversion is necessary, thereafter converting the at least one of said family of CNF files into said equipment specific format files that match the needs of said book reproduction system; and

e) reproducing said book at said book reproduction system.

Claim 1 has been amended to read:

A print-on-demand method for creating and reproducing at least one of a plurality of books by heterogeneous systems, said method comprising the steps of:

a) obtaining and generating digital book files representing the least one book of a plurality of books in a Common Normal Format (CNF), wherein the CNF comprise at least one [[in]] portable document format (PDF), job definition format (JDF), [[and]] scalable vector graphics (SVG) format, and similar solution-independent format encased within an Extensible Markup Language (XML) framework;

b) fashioning said book files to reflect attributes imposed by said JDF;

c) storing said digital book files within a repository;

d) generating said at least one book from said book files utilizing hardware and software to shape said framework in order to accommodate solution-independence said book file formatting, directly, without conversion from an equipment dependent format through a bookbinding process as prescribed by a just-in-time production schema

(e) reproducing said book within said just-in-time schema or as-needed basis, eliminating inventory overhead;

f) editing said book through imposition of pages and insertion of advertising of the at least one CNF book within the XML framework, wherein said editing being viewable on a viewing device and facilitated by having an editing instruction set encoded in JDF within said XML framework;

g) said editing instruction set accessible throughout an XML prepress pipeline shaped by said XML framework;

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of obtaining and generating digital book files representing the least one book of a plurality of books in a Common Normal Format (CNF), wherein the CNF comprise at least one [[in]] portable document format (PDF), job definition format (JDF), [[and]] scalable vector graphics (SVG) format,

and similar solution-independent format encased within an Extensible Markup Language (XML) framework; fashioning said book files to reflect attributes imposed by said JDF; storing said digital book files within a repository; generating said at least one book from said book files utilizing hardware and software to shape said framework in order to accommodate solution-independence said book file formatting, directly, without conversion from an equipment dependent format through a bookbinding process as prescribed by a just-in-time production schema; reproducing said book within said just-in-time schema or as-needed basis, eliminating inventory overhead; editing said book through imposition of pages and insertion of advertising of the at least one CNF book within the XML framework, wherein said editing being viewable on a viewing device and facilitated by having an editing instruction set encoded in JDF within said XML framework; said editing instruction set accessible throughout an XML prepress pipeline shaped by said XML framework.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in independent claim 1, as amended, dependent claims 3-19 are no longer unpatentable under 35 U.S.C. 103. Based on the foregoing, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejections of claims 1-19 based on the Kato '236 patent publication be withdrawn.

Regarding claim 2, the Examiner has cancelled claim 2 in its entirety.

Regarding claim 9, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above the method in claim 1, wherein step d) comprises the step of: acquiring or generating hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]). Claim 9 has been amended to read:

The method in Claim 1, further comprises the step of: acquiring or generating hard copy book production information within JDF.

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of acquiring or generating hard copy book production information within JDF.

Regarding claim 10, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 9, wherein said book production information includes information pertaining to the printing information used by the printing equipment in the system; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]). Claim 10 has been amended to read:

The method in Claim 9, wherein said at least one book production information within JDF comprises printing information.

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of wherein said at least one book production information within JDF comprises printing information.

Regarding claim 11, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 9, wherein said book production information comprises binding information; (i.e. the book printing attribute information includes information pertaining to the binding information used by the equipment that will perform the book binding operation; citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]). Claim 11 has been amended to read:

The method in Claim 9, wherein said at least one book production information within JDF comprises printing information.

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of wherein said at least one book production information within JDF comprises binding information.

Regarding claim 14, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein step d) further comprises the step of; acquiring or generating hard copy book production information (i.e. when the system produces

information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]). (Please take note of rejection dependency issues noted above.) Claim 14 has been amended to read:

The method in claim 13, further comprises the step of: acquiring or generating hard copy book production information via JDF.

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of acquiring or generating hard copy book production information via JDF.

Regarding claim 15, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises security information (i.e. in the system, the qualification of the user to print is checked in the system. The Examiner argued that the qualifications of the user that is checked can be considered as security information; (citing paragraph [0111])). Claim 15 has been amended to read:

The method in Claim 1, wherein the method of claim 1 further discloses said book production information within JDF comprises security information.

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of said book production information within JDF comprises security information.

Regarding claim 16, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises viewing capabilities (i.e. in the system, when opening a book file using the bookbinding application, the display methods that are designated by the user, considered as viewing capabilities, affects how the job is viewed on the display. The Examiner argued that when displaying the image data, the manner in which the

book is produced can be displayed. The Examiner argued that this is an example of the system acquiring displaying capability information from the requester of information; (citing paragraph [0112] and [0113]). Claim 16 has been amended to read:

The method in Claim 1, wherein the method of claim 1 further discloses said at least one book, said book production information within JDF comprises viewing capabilities.

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of said at least one book, said book production information within JDF comprises viewing capabilities.

Regarding claim 17, the Examiner argued that teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises printing capabilities (i.e. in t he system, when obtaining e-book creation information, which is analogous to the book production information, the printing capabilities of the requester is obtained; (citing FIGS. 1-3, paragraphs [0007]-[0023]). Claim 17 has been amended to read:

The method in Claim 1, wherein the method of claim 1 further discloses said at least one book, said book production information within JDF comprises printing capabilities.

Applicant respectfully submits that Kato '236 in view of Sangroniz et al does not hint at, teach nor suggest the step of said at least one book, said book production information within JDF comprises printing capabilities.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of independent claim 1 apply equally against the rejections of dependent claims 4-11, and 14-17. As submitted above, Kato in view of Sangroniz does not disclose all of the Applicant's claim 1 steps. Also, examiner failed to address the issues with rejecting claim 14 with two references and parent claim 13 with three references.

Therefore Kato in view of Sangroniz fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claims 9- 11, and

14- 17 is not disclosed. Too, based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(e) rejections of claims 1, 9- 11, and 14- 17 based on Kato in view of Sangroniz and 4-8 further in view of Clark be withdrawn.

Regarding claim 20, the Examiner argued that Kato discloses a print-on-demand system for creating and reproducing books by heterogeneous reproduction workflows, said system comprising:

At least one of a scanner, memory and data network for obtaining book contents for a book targeted for reproduction (i.e., when viewing figure 19, the local hard disk and network drive is used to store, or obtain, a book file that could be printed in the system by the local and network printer. Also, the data network connecting the client PC to the document management server can be considered as the data network used to obtain book files consisting of contents related to pages and chapters of a book; see figure 19; paragraphs [0056-[0062] & [0105]-[0113]]);

a book file generator to generate to distribute a digital representation of said book, transmittable in the form of at least one of a portable document format (PDF), job definition format (JDF), and scalable vector graphics (SVG) format, wherein all said format being collectively termed family of common normal formats (CNF) in light of being reproduction system and solution independent within a reproduction process (i.e., when viewing figure 19, the local hard disk or network drive is to store, or obtain, a book file that can be printed in the system by the local or network printer. Also, the data network connecting the client PC to the document management server can be considered as the data network used to obtain book files consisting of contents related to pages and chapters of a book. The content of the book files are obtained from a computer memory in an intermediate format that includes print attributes in JDF. The files can be obtained and generated in SVG, JDF, and PDF from the computer and sent to a memory in a server, in

a despooler in the computer or to a network printing device; see fig. 19; paragraphs [0056]-[0062] and [0105]-[0121]);

a CNF file converter to convert said book files into at least one of a CNF file of the family of CNF files that is reproduction system and solution-independent (i.e., the intermediate produced from using the information regarding the original of each page and the SVG is considered as the common normal format since this code is independent from the reproduction system and it is considered as an intermediate file format data. Several files can be considered as a mastered book. With different pages and chapters able to be added to an already existing book and the pages are represented by PDF or SVG combined with attributes in JDF or DEVMODE, the feature of having book files converted, or processed, into a complete book and embodied in a language independent from the reproduction system performs the above feature; see paragraphs [0077]-[0100] and [0120]);

a book file memory within a repository to store the CNF file of the family of CNF files representing said book targeted for reproduction as a mastered book; (i.e. the intermediate code storage module (107) is used to store the intermediate code, considered as common normal format files, that represents the data pertaining to the book to be printed. The Examiner argued that citing in FIG. 21, the image data is stored in the intermediate code storage module before further processing for printing or producing the book, which concurs with the feature of having the files stored in memory representing the book to be printed that contains all the contents related to the book to be produced. Shown in figure 19, the document management server (12010) is also used to store a book file that has been created and edited by the bookbinding application (1040). The book file that has been converted into the intermediate file format by the electronic writer (1020) before transferred from the bookbinding application to the document

management server (12010); see figures 19 and 21; paragraphs [0105]-[0113]);

an equipment specific format (ESF) file converter to determine if the at least one of said CNF file need to be converted into the ESF file based on a book reproduction equipment to be utilized for reproduction and if conversion is necessary, thereafter to convert said CNF files into said ESF files matching the needs of said book reproduction equipment being utilized to reproduce said book (i.e., in the system, when processing the book files, an error can occurs in the system. When a generation of an error in outputting information in the printer occurs, the system detects or determines, the page in which errors have been made in the system. Shown in figure 4 is the detection of this information. Different processes take place depending on the situation regarding the sheet in error. However, regardless of the different processes, the sheet is re-printed in figure 7. Based on the error processing shown in figure 3, the system determines if an error occurs in the output process. Then the system determines which files that are in an intermediate format need to be reprinted. Finally, in figure 7, the system determines which pages need to be reprinted and generates PDL data from the book files in intermediate code. As shown in figure 25, the system determines the reprint start pages and based on these pages, the system determines that these page or pages in the intermediate format need, or is required, to be output to print data in order to be output by the printer; see 3-7 and 25, paragraphs [0131]-[0158]) and if conversion is necessary, thereafter to convert said CNF files into said ESF files matching the needs of said book reproduction equipment being utilized to produce said book (i.e., in the system, the intermediate code generation module was used to convert the original data and the print attribute data , which is represented in JDF, into intermediate code data. This information is stored in the intermediate code memory.

Next, the system then obtains the intermediate code and converts the code into print data (e.g. PDL in order for the printer to receive information in a format that is recognizable to the printer. The data converted to PDL is analogous to converting previous data that is specific to the printing equipment used in the system in order to match the pre-printing requirements of the printer so that the printer is able to recognize the information and output the print data. Since the intermediate data includes the JDF and the intermediate data is converted into PDL, or print data, the above feature of converting the intermediate files into equipment specific files that includes the contents of the JDL information is performed; see fig. 21; paragraphs [0115]-[0121]); and

A book reproducer to reproduce said book from information comprised by said ESF files (i.e. the local or network printers shown in FIG. 19 or the printers connected to the LAN (104) shown in FIG. 1 are considered as the book reproducers that are able to output a book from the information converted into PDL that is interpreted by the printer for printing; (citing FIGS. 1, 19 and 21; paragraphs [0115]-[0121])).

However, the Examiner admitted that Kato fails to specifically teach transmittable in the form of at least one of job definition format (JDF). The Examiner argued however, that this is well known in the art as evidenced by Sangroniz.

The Examiner argued that Sangroniz discloses transmittable in the form of at least one of JDF. The Examiner argued that the system of Sangroniz is similar to the system of Kato in the manner in which both systems involve a client device sending printing information to an apparatus to be printed. However, the Examiner argued that in Sangroniz, the print facility that receives job ticket information, the job ticket is described in JDF format. This same job ticket is received from a client through a network, or

from a storage device. The Examiner argued that since the Kato device can consist of a host computer and a printer or consists only of one printing apparatus, the feature of obtaining information in JDF into a single apparatus can perform the above feature (citing Kato paragraphs [0008] - [0011]).

The Examiner argued that, therefore, in view of Sangroniz, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of obtaining book files in JDF, incorporated in the device of Kato, in order to obtain job tickets submitted to a printing system that is expressed in the JDF format (citing Sangroniz paragraph [0002]).

Claim 20 has been amended to read:

A print-on-demand system for creating and reproducing at least one of a plurality of books by heterogeneous reproduction workflows, said system comprising:

at least one of a scanner, memory and data network for obtaining book contents for a book targeted for reproduction;

a book file generator to generate a digital book file to distribute a digital representation of said at least one book, transmittable in the form of a Common Normal Format (CNF), wherein said CNF comprises of at least one of a portable document format (PDF), job definition format (JDF), scalable vector graphics (SVG) format, and similar solution-independent formats within an Extensible Markup Language (XML) framework, wherein all printing and viewing of said at least one book file is done directly from said XML framework free from restraints of equipment-dependent formatting;

a book file memory of said at least one book file of said at least one book within a repository to store a CNF file representing said at least one book targeted for reproduction; and reproduction hardware and software that can reproduce a solution-independent book file of said at least one book, from said book file generator, directly, without any said book file format conversion as prescribed by an efficient just-in-time production schema.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the steps of what are now found in claim 20, as amended, claims 20-38 are no longer unpatentable under 35 U.S.C. 103. Based on the foregoing, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejections of claims 20-38 based on the Kato '236 patent publication be withdrawn.

Regarding claim 21, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein the digital representation of said book in a pre-distribution phase is formed in at least one of a PDF and JDF format within the family of CNF formats (i.e., the system of Kato '236 discloses that files can be represented in either PDF or JDF. The documents can be represented in this format before the documents are distributed to a printing device; see paragraph [0057-0059]), and downstream of said pre-distribution phase communication transmission formatting transitions to an SVG format, via standalone or existing applications (i.e., in the system once the electronic writer acquires the information from the application upstream on the processing pipeline, the book files can be developed into the SVG format in order to be further processed by the bookbinding application or other applications to further processing the document information (see paragraph [0057-0062]), possessing a structural file format that increases versatility in manipulating online content beyond the PDF format capabilities (i.e., with the use of SVG format, the system clearly uses the advantages of the programming language that makes up the print job, but with the bookbinding information, the use of the SVG format in the manipulation of the intermediate file format lends itself to being modified in a way that other languages could not be in the Kato system since the XML used in the SVG format is a simpler language than the languages that makeup the PDF format; see paragraph [0057]-[0062]), all encapsulated within an XML pipeline (i.e., the SVG being used, the processing of this data occurs within an XML pipeline, since this pipeline of processes in the system manipulated different aspects of the XML in order to perform the eventual output of the image data; see paragraph [0057]-[0062]) and [0120]. Claim 21 has been amended to read:

The system in Claim 20, wherein the digital representation of said book is formed in at least one of the [[a]] PDF, SVG, and JDF format within the XML framework, and wherein said at least one solution-independent book file can be edited with content disposition and advertising within the XML framework irrespective of the project completion level.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 21, as amended, dependent claims 21, 23-27, and 31 are no longer unpatentable under 35 U.S.C. 103. Based on the foregoing, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejections of claims 21, 23-27, and 31 based on the Kato '236 patent application reference be withdrawn.

Regarding claim 28, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises; a book production information generator adapted to generate hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]). Claim 28 has been amended to read:

The system in claim 20, wherein said solution-independent XML framework comprises:

a book production information generator to generate hardcopy book production information.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 28, as amended, claims 29, 30, 34, and 35 are no longer unpatentable under 35 U.S.C. 103. Based on the foregoing, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejections of claims 28-30, 34, and 35 based on the Kato '236 patent application reference be withdrawn.

Regarding claim 29, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein said book production information comprises printing equipment information (i.e. the book printing attribute information includes information pertaining to the printing information used by the printing equipment in the system; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120])). Claim 29 has been amended to read:

The system in claim 20, wherein said at least one book production information comprises printing equipment information.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 29, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 30, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein said book production information comprises binding equipment information (i.e. the book printing attribute information includes information pertaining to the binding information used by the equipment that will perform the book binding operation; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120])). Claim 30 has been amended to read:

The system in claim 20, wherein said at least one book production information comprises printing equipment information.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 30, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 33, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises: a book

production information generator adapted to generate hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered by the Examiner as producing generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]). Claim 33 has been amended to read:

The system in claim 20, wherein linked to said solution-independent XML framework comprises:

a book production information generator to generate hard copy book production information.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 33, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 34, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein for electronic books, said book production information comprises security information (i.e. in the system, the qualification of the user to print is checked in the system. The Examiner argued that the qualifications of the user that is checked can be considered as security information; (citing paragraph [0111]). Claim 34 has been amended to read:

The system in claim 20, wherein for said at least one book file, said book production information comprises security information.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 34, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 35, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system

in claim 28, wherein for electronic books, said book production information comprises viewing capabilities (i.e. in the system, when opening a book file using the bookbinding application, the display methods that are designated by the user, considered as viewing capabilities, affects how the job is viewed on the display. The Examiner argued that when displaying the image data, the manner in which the book is produced can be displayed. The Examiner argued that this is an example of the system acquiring displaying capability information from the requester of information; citing paragraph [0112] and [0113]). Claim 35 has been amended to read:

The system in claim 20, wherein for said at least one book file, said book production information comprises viewing capabilities.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 35, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 36, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein for electronic books, said book production information comprises printing capabilities (i.e. in the system, the printing attributes are related to the book file being printed is considered as the printing capabilities since these attributes define the manner in which to develop or create the book file in the printer; citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]). Claim 36 has been amended to read:

The system in claim 20, wherein for said at least one book file, said book production information comprises printing capabilities.

Because Kato '236 in view of Sangroniz et al fail to hint at, teach or suggest the step of what is now found in claim 36, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of independent claim 20 apply equally against the rejections of dependent claims 20, 21, 28-30 and 33-36.

Therefore Kato in view of Sangroniz fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims 20, 21, 28-30 and 33-36 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 20, 21, 28-30 and 33-36 based on Kato in view of Sangroniz be withdrawn. This amendment is for the purpose of placing the application in a condition for allowance.

Kato in view of Sangroniz and Warmus

The Examiner rejected claims 3, 12, 13, 22, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Sangroniz and further in view of Warmus (U.S Patent No. 6,332,149).

Regarding claim 3, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 1, wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book; and converting scanned components of said book into said digital representation.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book (i.e. in the system, a scanner can be used to scan an input copy, citing Warmus col. 8, lines 8-30); and converting scanned components of said book into said digital representation (i.e. the Examiner argued that like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information). The Examiner argued that with the scanning of an input copy and producing a movie or some non-static information, the conversion of scanned information into a movie or other

non-static information is understood to be in a digital representation; (citing Warmus col. 8, lines 8-30).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book and converting scanned components of said book into said digital representation in order to have a scanner which scans an input copy (citing Warmus, col. 8, lines 8-10). (Please take note of rejection dependency issues noted above.) Claim 3 has been amended to read:

The method in claim 1, wherein said at least one book is originally in the form of a hard copy, and further comprises the steps of: scanning the components of said book; and converting scanned components of said book into said digital representation.

Because Kato '236 in view of Sangroniz et al and further in view of Warmus, fail to hint at, teach or suggest the step of what is now found in claim 3, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 12, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, further comprises the step of: via a Raster Image Processor, creating a bitmap of the book block (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraph [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor. The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP Raster Image Processor) used to create

bitmaps of book pages that can be displayed; (citing FIG. 6, col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor creating a bitmap of the book block in order to have a display device display pages (citing Warmus, col. 7, lines 24-31). Claim 12 has been amended to read:

The method in claim 1, further comprises the step of: via a Raster Image Processor within the post prepress phase, creating a bitmap of the book block.

Because Kato '236 in view of Sangroniz et al, and further in view of Warmus fail to hint at, teach or suggest the step of what is now found in claim 12, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 13, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein step d) further comprises the step of: via a Processor, creating a bitmap of the book cover (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraphs [0070] and [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor. The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus disclosed having a RIP used to create bitmaps of book pages, which includes cover pages, which can be displayed; (citing FIG. 6, col. 8, lines 63-67, col. 9, and lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a RIP creating a bitmap of the book cover in order to have display device display pages (citing Warmus, col. 7, lines 24-31). (Please take note of rejection dependency issues noted above.) Claim 13 has been amended to read:

The method in claim 1, further comprises the step of: via a Raster Image Processor, creating a bitmap of the book block.

Because Kato '236 in view of Sangroniz et al, and further in view of Warmus fail to hint at, teach or suggest the step of what is now found in claim 13, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 22, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner admitted that however, Kato fails to teach the system in claim 20, wherein said book in step a) is originally in the form of a hard copy, and said book file generator further comprises: a book scanner adapted to scan the components of said book; and a scanned component converter adapted to convert scanned components of said book into said digital representation.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses wherein said book in step a) is originally in the form of a hard copy, and said book file generator further comprises: a book scanner adapted to scan the components of said book (i.e. in the system, a scanner can be used to scan an input copy; (citing col. 8, lines 8-30); and a scanned component converter adapted to convert scanned components of said book into said digital representation (the Examiner argued like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information . The Examiner argued that with the scanning of an input copy and producing a movie or some non-static information, the conversion of scanned information into a movie or other non-static information, the conversion of scanned information into a movie or other non-static information is understood to be in a digital representation; (citing Warmus col. 8, lines 8-30).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a book scanner adapted to scan the components of said book; and a scanned component converter adapted to convert scanned components of said book

into said digital representation in order to have a scanner which scans an input copy (citing Warmus, col. 8, lines 8-10). Claim 22 has been amended to read:

The system in claim 20, wherein said at least book is originally in the form of a hard copy, and said book file generator further comprises: a book scanner adapted to scan the components of said book; and a scanned component converter adapted to convert scanned components of said at least one book into said digital representation.

Because Kato '236 in view of Sangroniz et al, and further in view of Warmus fail to hint at, teach or suggest the step of what is now found in claim 22, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 31, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises: a Processor adapted to create a bitmap of the book block (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraph [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the Examiner argued the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP (Raster Image Processor) used to create bitmaps of book pages that can be displayed; (citing FIG. 6; col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor adapted to create a bitmap of the book block in order to have a display device display pages (citing Warmus, col. 7, lines 24-31). Claim 31 has been amended to read:

The system in claim 20, wherein within said XML framework comprises: a Processor adapted to create a bitmap of the at least one book.

Because Kato '236 in view of Sangroniz et al, and further in view of Warmus fail to hint at, teach or suggest the step of what is now found in claim 31, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 32, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner argued that Kato discloses the system in claim 20, further comprises: a Raster Image Processor to create a bitmap of the book cover (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17; paragraphs [0070] and [0082].

The Examiner admitted that however, Kato fails to teach Raster Image Processor.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP (Raster Image Processor) used to create bitmaps of book pages, which includes cover pages, which can be displayed: citing FIG. 6; col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor adapted to create a bitmap of the book cover in order to have a display device display pages (citing Warmus, col. 7, lines 24-31). Claim 32 has been amended to read:

The system in claim 20, further comprises: a Raster Image Processor adapted to create a bitmap of a book cover.

Because Kato '236 in view of Sangroniz et al, and further in view of Warmus fail to hint at, teach or suggest the step of what is now found in claim 32, as

amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Therefore, Kato in view of Sangroniz and further in view of Warmus fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims is not disclosed. Furthermore, the Examiner has not provided an explicit rationale to combine the references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C §103(a) rejections of claims 3-8, 12, 13, 22-27, 31 and 32 based on Kato in view of Sangroniz and further in view of Warmus be withdrawn.

Kato in view of Sangroniz and Clark et al.

The Examiner rejected claims 4-8, 18, 19, 23-27, 37 and 38 under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Sangroniz and further in view of Clark et al. (U.S. Patent Publication No. 2002/0152215) hereinafter referred to as "Clark".

Regarding claim 4, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato fails to teach disclose the method in previously amended claim 1, wherein said book identification information comprises the book title.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book title (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs {0022}-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book title in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]). Claim 4 has been amended to read:

The method in claim 1, wherein said at least one book identification information within JDF comprises a book title.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 4, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 5, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in previously amended claim 1, wherein said book identification information comprises the book author (i.e. in the system, book identification information includes an author; (citing FIGS. 1-3; paragraphs [0007]-[0023]).

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book author (the Examiner argued that, i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book author in

order to obtain information on eBooks or “print-on-demand” titles offered on the network (citing Clark, paragraph [0035]). Claim 5 has been amended to read:

The method in claim 1, wherein said at least one book identification information within JDF comprises a book author.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 5, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 6, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in previously amended claim 1, wherein said book identification information comprises the book publisher.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publisher (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs {0022}-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown in FIG. 6 is an example of a publisher creating information related to the eBooks and “print-on-demand” titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publisher in order to obtain information on eBooks or “print-on-demand” titles offered on the network (citing Clark, paragraph [0035]). Claim 6 has been amended to read:

The method in claim 1, wherein said at least one book identification information within JDF comprises a book publisher.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 6, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 7, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in previously amended claim 1, wherein said book identification information comprises the International Standard Book Number (ISBN).

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the ISBN (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022][0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the ISBN in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]). Claim 7 has been amended to read:

The method in claim 1, wherein said at least one book identification information within JDF comprises the International Standard Book Number.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 7, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 8, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in previously amended claim 1, wherein said book identification information comprises the book publishing date.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publishing date (i.e. the reference of Clark offers a print-on-demand titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publishing date in order to obtain information on eBooks or "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publishing date in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]). Claim 8 has been amended to read:

The method in claim 1, wherein said at least one book identification information within JDF comprises the at least one book publishing date.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 8, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 18, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1 wherein step e) comprises for electronic books, the step of: providing access to said book via an electronic link to a data network.

The Examiner argued that, however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein step e) comprises for electronic books, the step of: providing access to said book via an electronic link to a data network (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or a link, is sent to the user to provide access to the purchased eBook; (citing FIG. 16; paragraphs [0068]-[0074]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of an providing access to said book via an electronic link to a data network in order to enable a consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]). Claim 18 has been amended to read:

The method in claim 1, wherein the method of claim 1 further discloses the step of: providing access to said at least one book via an electronic link to a data network.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 18, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 19, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1 wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook. The Examiner argued that the user then receives the eBook from the server (210) that handles distribution of the eBook. The Examiner argued that the feature of a link delivering a book to the predefined destination (e.g. the consumer client computer (208) over a data network (202); (citing FIG. 16-18; paragraphs [0068]-[0077]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination in order to enable a consumer "print-on-demand" hard copies of title (citing Clark, paragraph [0069]). Claim 19 has been amended to read:

The method in claim 1, wherein the method of claim 1 further discloses the step of: delivering said at least one book to a predefined destination in order to enable a consumer "print-on-demand" hard copies of title.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 19, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 23, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 21, wherein said book identification information comprises the book title.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book title (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date: (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book title in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]). Claim 23 has been amended to read:

The system in claim 21, wherein said at least one book identification information within JDF comprises the book title.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 23, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 24, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 21, wherein said book identification information comprises the book author.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book author (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book author in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]). Claim 24 has been amended to read:

The system in claim 21, wherein said at least one book identification information within JDF comprises the book author.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 24, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 25, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach discloses the system in claim 21, wherein said book identification information comprises the book publisher.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprised the book publisher (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publisher in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]). Claim 25 has been amended to read:

The system in claim 21, wherein said at least one book identification information within JDF comprises the book publisher.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 25, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 26, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 21, wherein said at least one book identification information within JDF comprises the ISBN.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the ISBN (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is

mentioned in paragraphs [0022][0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the ISBN in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]). Claim 26 has been amended to read:

The system in claim 21, wherein said at least one book identification information within JDF comprises the International Standard Book Number.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 26, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 27, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 21, wherein said book identification information comprises the book publishing date.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publishing date (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that the information offered

includes the publisher, publisher reference number and publication date; (citing Clark, paragraph [0035]). Claim 27 has been amended to read:

The system in claim 21, wherein said at least one book identification information within JDF comprises the book publishing date.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 27, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 37, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 20 wherein said book reproducer comprises for electronic books: an electronic link adapted to provide access to said book.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book reproducer comprises for electronic books: an electronic link adapted to provide access to said book (9.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook; (citing FIG. 16, paragraphs [0068]-[0074]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of an electronic link adapted to provide access to said book in order to enable consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]). Claim 37 has been amended to read:

The system in claim 20 wherein said reproduction workflows comprises: an electronic link to provide access to said at least one book.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 37, as amended,

the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

Regarding claim 38, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 20 wherein said book reproducer comprises for electronic books: an electronic link adapted to deliver said book to a predefined destination over a data network.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book reproducer comprises for electronic books: an electronic link adapted to deliver said book to a predefined destination over a data network (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook. The Examiner argued that the user then receives the eBook from the server (210) that handles distribution of the eBook. The Examiner argued that the feature of the server delivering the eBook to the consumer performs the feature of a link delivering a book to the predefined destination (e.g. the consumer client computer (208) over a data network (202); (citing FIGS. 16-18; paragraphs [0068]-[0077])).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book reproducer comprises for electronic books: an electronic link adapted to deliver said book to a predefined destination over a data network in order to enable a consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]). Claim 38 has been amended to read:

The system in claim 20 wherein said reproduction workflows comprises: an electronic link adapted to deliver said at least one book via an XML pipeline using CNF files to a predefined destination over a data network.

Because Kato '236 in view of Sangroniz et al and further in view of Clark, fail to hint at, teach or suggest the step of what is now found in claim 38, as amended, the applicant respectfully requests that the 35 U.S.C. 103 (a) rejection based on the Kato '236 patent application reference be withdrawn.

In light of the newly amended claims 1, 20, and 21 the rejections of claims 4-8, 18, 19, 23-27, 37 and 38 are moot if deemed allowable. In particular Kato in view of Sangroniz and additionally further in view of Clark does not disclose the newly amended claim matter that follows: 1) obtaining and generating digital book files representing the least one book of a plurality of books in a Common Normal Format (CNF), wherein the CNF comprise at least one [[in]] portable document format (PDF), job definition format (JDF), [[and]] scalable vector graphics (SVG) format, and similar solution-independent format encased within an Extensible Markup Language (XML) framework; fashioning said book files to reflect attributes imposed by said JDF; c) storing said digital book files within a repository; generating said at least one book from said book files utilizing hardware and software to shape said framework in order to accommodate solution-independence said book file formatting, directly, without conversion from an equipment dependent format through a bookbinding process as prescribed by a just-in-time production schema; reproducing said book within said just-in-time schema or as-needed basis, eliminating inventory overhead; editing said book through imposition of pages and insertion of advertising of the at least one CNF book within the XML framework, wherein said editing being viewable on a viewing device and facilitated by having an editing instruction set encoded in JDF within said XML framework; said editing instruction set accessible throughout an XML prepress pipeline shaped by said XML framework (Claim 1); 2) (claim 20) a book file generator to generate a digital book file to distribute a digital representation of said at least one book, transmittable in the form of a Common Normal Format (CNF), wherein said CNF comprises of at least one of a portable document format (PDF), job definition format (JDF), scalable vector graphics (SVG) format, and similar solution-independent formats within an Extensible Markup Language (XML) framework, wherein all printing and viewing of said at least one book file is done directly from

said XML framework free from restraints of equipment-dependent formatting; a book file memory of said at least one book file of said at least one book within a repository to store a CNF file representing said at least one book targeted for reproduction; and reproduction hardware and software that can reproduce a solution-independent book file of said at least one book, from said book file generator, directly, without any said book file format conversion as prescribed by an efficient just-in-time production schema;

3) wherein the digital representation of said book is formed in at least one of the [[a]] PDF, SVG, and JDF format within the XML framework, and wherein said at least one solution-independent book file can be edited with content disposition and advertising within the XML framework irrespective of the project completion level. (claim 21).

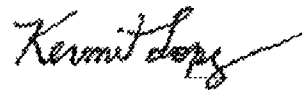
Therefore, Kato in view of Sangroniz and further in view of Clark fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims 18, 19, 37 and 38 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C §103(a) rejections of claims 4-8, 18, 19, 23-27, 37 and 38 based on Kato in view of Sangroniz and further in view of Clark be withdrawn.

II. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejection under §103 based on the preceding remarks. Reconsideration and allowance of Applicant's claims is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kermit Lopez", with a stylized flourish extending from the end.

Dated: February 3, 2010

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